

**REMARKS**

In response to the Office Communication mailed June 28, 2007, Applicants submit the foregoing claim amendments and the following remarks. Claims 1-17 have been canceled, without prejudice, and with the reservation that the same subject matter may be submitted in one or more copending applications claiming priority from this or one or more related applications. Claim 18 has been amended to stand in independent form, including all the limitations of claim 1. New claims 21-41 have been added, and introduce no new matter. Applicants request favorable consideration of claims 18-41. Such action is respectfully requested.

**Claim Rejection - 35 U.S.C. 103 over Hofmann '525 and Enggaard**

Claims 1-2, 5-6, 8-12, 14-15, 17 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Hofmann '525 (US 5,273,525) in view of Enggaard (US 6,899,699). This rejection is respectfully traversed for at least the following reasons. While Applicants do not necessarily agree with the rejection, in the interest of expediting prosecution, claims 1-2, 5-6, 8-12, 14-15, and 17 have been canceled, without prejudice, and with the reservation that the same subject matter may be submitted in one or more copending applications claiming priority from this or one or more related applications. Thus, the foregoing amendment has rendered this rejection; and the rejection should be withdrawn. Such action is therefore requested.

**Claim Rejection - 35 U.S.C. 103 over Hofmann '893**

Claims 1-20 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Hofmann (US 6,208,893). Applicants respectfully request reconsideration of this rejection in view of the following remarks.

While Applicants do not necessarily agree with the rejection, in the interest of expediting prosecution, claims 1-17 have been canceled, without prejudice, and with the reservation that the same subject matter may be submitted in one or more copending applications claiming priority from this or one or more related applications. Thus, the foregoing amendment has rendered this rejection moot with respect to claims 1-17.

Claim 18 has been amended to recite all the limitations of claim 1, as well as the limitations of original claim 18. Claims 19 and 20 ultimately depend from claim 18, and thus would be unobvious in view of the prior art for at least the same reasons as claim 18. Applicants submit that

the rejection of claims 18-20 as being obvious under 35 U.S.C. § 103(a) is untenable and should be withdrawn.

According to the Office Action: “Hofmann teaches several embodiments of an electroporation device including figures 24, 25 which teaches an infusion orifice at the tip of element 178 which is connected to the infusion line 180. Penetrating electrodes are shielded by cover member 162.” Further according to the Office Action, “Applicant differs from Hofmann in reciting a controlled source of energy.” Yet, according to the Office Action, “To have used known controlled infusion devices such a spring driven (Class 604/135 or pressurized gas 604/140), both of which are considered “jet” injectors, would have been obvious to one of ordinary skill in the art.” Thus, as best understood by the Applicants, the position of the Office is that the Hofmann ‘893 teaches an extendable shield means for shielding either the agent orifice or the electrodes from a user of the apparatus when the orifice or the electrodes are not in contact with the patient.

Applicants traverse the rejection of claims 18-20, at least for the reason that the Office has failed to recognize at least one difference between the device described by the Hofmann ‘893 reference and the device defined by instant claim 18, and have thus failed to provide a rational underpinning to support the legal conclusion of obviousness. *See, KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)(citing, with approval, *In re Kahn*, 441 F.3d 977, 988 [78 USPQ2d 1329] (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). In particular, what the Office characterizes as a “cover member 162” is not “an extendable shield means for shielding either the agent orifice or the electrodes from a user of the apparatus when the orifice or the electrodes are not in contact with the patient,” as required by instant claim 18. *See*, Hofmann ‘893, column 14, lines 10-14, and Figure 24. *Id.* Rather, 162 is a “flexible catheter member”. According to Hofmann ‘893, “an elongated flexible catheter member 162 is fitted at a distal end with a template 164) having a plurality of through-sockets with sliding connectors 166, 168, 170 and 172.” *Id.* From the drawings in Figure 24, it is apparent that the “flexible catheter member 162” is not extendable; rather it is the electrodes that extend into tissue. In contrast, instant claim 18 requires that the shield be extendable in order to shield the agent orifice or the electrodes from the user of the apparatus when the orifice or the electrodes are not in contact with the patient. This feature is not disclosed or suggested by

Hofmann '893. Furthermore, as the Office Action failed to note this difference between the claimed subject matter and the device depicted and described by Hofmann '893, the Office Action fails to support the conclusion of obviousness with an adequate rational underpinning to support the legal conclusion of obviousness. For this reason, Applicants respectfully request that the rejection of claims 18-20 over Hofmann '893 be withdrawn.

**Provisional Double Patenting**

Claims 1-20 were provisionally rejected under the judicially created grounds of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-20 of U.S. Patent No. 6,912,417.

Applicants submit that the rejection is untenable and should be withdrawn. As pointed out above, claims 1-17 have been canceled, without prejudice, and with the reservation that the same subject matter may be submitted in one or more copending applications claiming priority from this or one or more related applications. Thus, the foregoing amendment has rendered this rejection moot with respect to claims 1-17.

Claim 18 has been amended to recite all the limitations of claim 1, as well as the limitations of original claim 18. Claims 19 and 20 ultimately depend from claim 18, and thus would be unobvious in view of the prior art for at least the same reasons as claim 18. Instant claim 18 requires that the shield be extendable in order to shield the agent orifice or the electrodes from the user of the apparatus when the orifice or the electrodes are not in contact with the patient. This feature is not recited in the claims of U.S. Patent No. 6,912,417. Furthermore, the Office Action fails to describe how this feature of claim 18 would have been obvious in view of the claims of U.S. Patent No. 6,912,417. Thus, the Office Action fails to support the conclusion of obviousness-type double patenting; and the rejection should be withdrawn.

**Newly Presented Claims 21-41**

Applicants further present herewith claims 21-41, which recite different embodiments of the instant invention. Support for these claims is found throughout the application, for example at page 6, lines 5-30, page 11, line 27 through page 12, line 3, and 27 line 29 through page 28 line 1. Favorable consideration of these claims is respectfully requested.

**CONCLUSION**

In view of the remarks and amendments submitted herein, Applicants believe that the Application is in condition for allowance and such action is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (858) 350-2215.

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI  
Professional Corporation

A handwritten signature in black ink, appearing to read "Peter R. Munson", with a stylized flourish at the end.

Peter R. Munson, Agent for Applicants  
Registration No. 43,821

Dated: July 14, 2009

650 Page Mill Road  
Palo Alto, CA 94304-1050  
Direct Dial: (858) 350-2337  
**Customer No. 21971**